UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,944	02/04/2000	Christopher Warnock	EBRY0001	9493

22862   7590   03/22/2011
GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

EXAMINER
LE, NANCY LOAN T

ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
03/22/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomatters@glenn-law.com
GlennDocketing@cpaglobal.com

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 November 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,15,17-21,55-75 and 78-86* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,15,17-21,55-75 and 78-86* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date *23 November 2010*.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   Applicant's Amendment/Remarks filed on 23 November 2010 is entered.

2.   All references to the capitalized versions of "Applicants" refer specifically to the

Applicants of record. Any references to lower case versions of "applicant" or

"applicants" refer to any or all patent "applicants". Unless expressly noted otherwise,

references to "Examiner" refers to the Examiner of record while reference to or use of

the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

3.   This paper is given Paper No. 20110125 by the Examiner. This Paper No. is for

reference purposes only.

Information Disclosure Statement

4.   The information disclosure statement (IDS) submitted on 23 November 2010 is in

compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure

statement is being considered by the examiner.

Status of Claims

5.   Claims *1-3, 15, 17-21, 55-75 and 78-86* are pending and have been examined.

6.   Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

8.   A patent may not be obtained though the invention is not identically
disclosed or described as set forth in section 102 of this title, if the
differences between the subject matter sought to be patented and the prior
art are such that the subject matter as a whole would have been obvious at
the time the invention was made to a person having ordinary skill in the art
to which said subject matter pertains. Patentability shall not be negatived
by the manner in which the invention was made.

9.   Claims *1-3, 15, 17-21, 55-75 and 78-86* are rejected under 35 U.S.C. 103(a) as

being unpatentable over US Patent No. 5444779 (Daniele).

10.   Daniele discloses a computer-implemented method for user access to document

content using a logic client device comprising:

11.   delivering to a user of said client logic device, via a document server, a first user

viewable version of the actual contents of a specific document residing at a said

document server on a first cost basis, said first user viewable version being protected by

a security server to prevent the user from performing a standard operation on said

version, said standard operation consisting of any of copying, printing or saving

(Daniele, at least Abstract, C 4 L 21-33, C 4 L 61 – C 5 L 47, C 7 L 45-52, C 8 L 40-63);

12.   delivering user-requested pages of a specific document from a document server

in a first user-viewable version comprising a form protected by a security server to a

user of a client logic device to permit said user viewing the actual contents of said

pages of said specific document and selecting by said user but not printing, copying or

saving by the user *(Daniele, at least Abstract, C 4 L 21-33, C 4 L 61 – C 5 L 47, C 7 L*

45-52, C 8 L 40-63);

13.   calculating with said document server a charge to permit the user to perform a

requested standard operation on a user-selected portion of said specific document on a

second cost basis (*Daniele, at least Abstract, C 4 L 34-40, C 4 L 61 – C 5 L 47, C 7 L

45-52, C 8 L 40-63*);

14.   delivering to said user, via said document server, a second version of the actual

contents of said specific document residing at said document server comprising said

user-selected portion of said specific document, wherein a user requested standard

operation is completed, in coordination with said document server, upon payment of the

calculated charge *(Daniele, at least Abstract, C 8 L 64 – C 9 L 26)*.

15.   Daniele does not expressly disclose a "document server" as claimed.

16.   However, the claimed "document server" is just a *non-functional descriptive*

material, and is not functionally related to the claimed "*media selection module*".

17.   The reviewing court has stated that "[w]here the printed matter is not functionally

related to the substrate, the printed matter will not distinguish the invention from the

prior art in terms of patentability". In Re Nagi 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864

(Fed. Cir. 2004), citing In Re Gulack 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983).

18.   Hence, the claimed phrase "document server" does not distinguish the invention

from the *server that contains documents* as disclosed in the Daniele reference in terms

of patentability.

Response to Arguments

19.   Applicant's arguments with respect to 103(a) rejection of claims 1 and 67 under Ginter '900 and Komatsu have been considered but are moot in view of the new ground of rejection as discussed above.

Conclusion

20.   Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to NANCY T. LE whose telephone number is (571) 272-7066. The examiner can normally be reached on Monday - Friday, 9:00am - 6:00pm Eastern Standard Time Eastern Standard Time.

21.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW J. FISCHER can be reached on (571) 272-6779.

22.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see **http://pair-direct.uspto.gov**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nancy Le
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621